

## **REMARKS**

Claims 1-21 remain pending in this application.

Applicants acknowledge, with appreciation, the withdrawal of the finality of the previous Office action, the withdrawal of the previous rejections over Ishizuka et al., and acknowledgement of receipt of certified copies of the priority documents. With regard to the Examiner's comment in paragraph 3 of the Office action, applicants are entitled to claim the benefit of the foreign priority applications without filing an English-language translation that may be required to overcome an intervening item of prior art. MPEP 201.15.

Claims 1-3 and 7-21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Yokota et al. (WO 03/022594 where the Office is relying on the English-language version - US2004/0157162). It should be noted that two of the inventors (Tomeba and Yamada) named in the Yokota et al. publication are the inventors named in the present application.

The Office has argued that Yokota et al. discloses a photosensitive resin composition that may comprise:

- (a) a resin having a number average molecular weight between 1000 and 100,000 and having a polymerizable unsaturated group;
- (b) an organic compound having a number average molecular weight of less than 1000 and having at least one polymerizable group per molecule; and wherein at least a part of (a) may be replaced with polydimethylsiloxane (paragraph 0055), which is allegedly equivalent to the organic silicon compound (c) with at least one Si-O bond in a molecule and no polymerizable unsaturated group in the molecule as recited in claim 1.

A careful reading of Yokota et al. at paragraphs 0054, 0055 and 0057 will reveal that Yokota et al. does not disclose that a plastomer, including a silicon such as polydimethylsiloxane, may replace at least a part of resin (a), but that at least a part of resin (a) may be a plastomer that is modified to introduce a polymerizable unsaturated group in accordance with the requirements for resin (a) (see paragraph 0057). In other words, when a plastomer is used, at least in part, as component (a), it must have or meet the requirements of (a) by having a polymerizable unsaturated group. So even if polydimethylsiloxane is used as at least part of (a), the resin would be a polydimethylsiloxane having a polymerizable unsaturated group having a number average molecular weight of 1000 or more or 100,000 or less (claim 2) which is distinct from the claimed "organic silicon compound having at least one Si-O bond in a molecule and having no polymerizable unsaturated group in the molecule."

Tokota et al. does not teach or suggest the claimed organic silicon compound, and does not establish a prima facie case of obviousness of the claimed invention for at least this reason. Accordingly, this rejection should be withdrawn.

Claims 4-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokota et al. in view of Harasta et al. (U.S. Patent No. 4,426,431). The Office takes the position that Yokota et al. teach the printing element of claims 1 and 3, but fails to disclose the silicon-containing compounds of claims 4-6. Applicants respectfully disagree with this position for the reasons advanced above with respect to claim 1. Accordingly, claims 4-6 are not rendered unpatentable by the combination of Yokota et al. and Harasta et al. for the same reasons advanced above because Harasta et al. does not cure the basic flaw in relying on the teachings of Yokota et al. alone.

In addition, while the Office relies on the teachings of Harasta et al. to allegedly disclose the organic silicon compound (c) of the present invention, a careful reading of Harasta et al. at col. 9, lines 50-52 will reveal that it teaches the use of a "polymerizable organofunctional silicone" which does not meet the requirement of the present claims that organic silicon compound (c) has "no polymerizable unsaturated group." Accordingly, this rejection should be withdrawn for this additional reason.

Prompt and favorable reconsideration of this application is requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 26, 2009

By: Charles E. Van Horn  
Charles E. Van Horn  
Reg. No. 40,266  
(202) 408-4000